

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Berkey et al.

**PETITION FOR FILING
PATENT APPLICATION BY
THE ASSIGNEE**

Serial No.: 10/085,798

Filing Date: 2/26/02

Title: BROADBAND ACCESS
OPTIMIZED FIBER AND METHOD
OF MAKING

Group Art Unit: TBA

Examiner: TBA

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

Applicants, Corning Incorporated, hereby petitions the Commissioner to accept the filing of the above-identified U.S. Patent Application by it, as the party to which the invention disclosed and claimed in said Patent Application rightfully belongs, and on behalf of and as agent for the inventor.

Affidavits are attached hereto providing proof of the pertinent facts concerning the refusal of the inventor to join in the present application for patent and establishing that Corning Incorporated has a sufficient proprietary interest in this matter to make application on behalf of and as agent for the inventor, and showing that such action is necessary to preserve the rights of the parties and to prevent irreparable damage.

The name and address of the inventor refusing to join in this application is as follows:

Yanming Liu
3 Granger Pond Way
Lexington, MA 02420

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OFFICE OF PETITIONS

The invention was developed under the authorization of Corning Incorporated by four inventors, one of whom was Yanming Liu, who was employed by Corning Incorporated to do so.

Upon information and belief, based on the precedent which will be discussed below, Corning Incorporated is entitled to clear title to the invention and to the above-identified patent application and any patent which issues thereon.

The Supreme Court of the United States in *Solomons v. United States*, 137 U.S. 342, 346 (1890) held:

If one is employed to devise or perfect an instrument, or a means for accomplishing a prescribed result, he cannot, after successfully accomplishing the work for which he was employed, plead title thereto as against his employer. That which he has been employed and paid to accomplish become, when accomplished, the property of his employer. Whatever rights as an individual he may have had in and to his inventive powers, and that which they are able to accomplish, he has sold in advance to his employer.

It is clear that an employee who is paid to develop an invention comes within the scope of the language cited. Furthermore, Yanming Liu agreed to assign any and all patent rights to Corning Incorporated as a condition of his employment. A copy of the Agreement signed by Yanming Liu is attached to Exhibit A enclosed herewith.

Since Yanming Liu was employed by Corning Incorporated, that is, paid compensation to develop a broadband access fiber, this invention belongs to Corning Incorporated and the inventor who contributed to the development of the device has a duty to assign the invention, patent application and any patent which issues thereon to Corning Incorporated and upon direction of Corning Incorporated execute an application therefor.

Yanming Liu has left the employ of Corning Incorporated and refuses to execute the papers required for filing the present patent application. In particular, on April 17, 2002, a copy of the Assignment and Declaration papers were sent by certified mail to Yanming Liu and Yanming Liu was asked to sign for these papers (Exhibit B). On May 14, 2002, another letter was sent to Yanming Liu asking him again to sign the papers. On May 17, 2002, Yanming Liu sent an e-mail (Exhibit G) to Robert L. Carlson and the undersigned Patent Agent, which indicated that once we agreed to compensate Yanming Liu appropriately, he would sign the documents. As evidenced by the Affidavit of Robert L. Carlson, when asked what this meant, Yanming Liu responded that he estimated it would take him 15 minutes per page to review the application and that he should be paid \$300.00 per hour. Corning Incorporated later offered to pay Yanming Liu what it believes is a reasonable compensation, i.e., \$65.00 per hour at 5 minutes per page to review the documents. \$65.00 per hour corresponds to Yanming Liu's previous hourly rate when he was a scientist employed by Corning Incorporated, not less than one (1) year ago. Yanming Liu refused this offer stating that this was "way too low".

Corning Incorporated is believed to be entitled to make such application on behalf of and as agent for the inventor pursuant to 37 C.F.R. 1.47(b).

The required fee pursuant to § 1.17(h) is enclosed.

DATE: 2 Jul 2002

Date of Deposit: 2 Jul 02

I hereby certify that this paper or fee is being deposited with the United States Postal Service under 37 CFR 1.10 on the date indicated above and is Addressed to the Commissioner of Patents and Trademarks, Washington, DC 20231

Signature

William J. Chervenak
William J. Chervenak

Respectfully submitted,

William J. Chervenak

Agent for Assignee
William J. Chervenak
Reg. No. 38,407
Corning Incorporated
SP-TI-3-1
Corning, NY 14831
(607) 974-3956

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CORNING INCORPORATED
Patent and Proprietary Information Agreement

Corning Incorporated:

In consideration of my employment in any capacity by Corning Incorporated (hereinafter called the Company) and of the salary or wages paid or to be paid to me by the Company.

1. I hereby covenant and agree to disclose to the Company all inventions made or conceived by me (whether made solely by me or jointly with others) from the time of entering the Company's employ until I leave, (a) relating to or growing out of any business then being carried on or being developed by the Company, or (b) which result from or are suggested by any work which I may do for or on behalf of the Company, said inventions to be and remain the sole and exclusive property of the Company or its nominees whether patented or not.

2. I further agree that, at the request of the Company, whether such request is made during or subsequent to such employment, I will, entirely at the expense of the Company and through Attorneys or Agents designated by it, make application for Letters Patent of the United States and any and all countries foreign thereto with respect to any or all of said inventions, forthwith assign all such applications to the Company and its successors and assigns, and furnish such assistance and do all things, including the signing of necessary papers, as may reasonably be required of me to aid in the preparation and prosecution of such patent applications.

3. I further agree that I will not, either during or subsequent to my employment, disclose in any manner whatsoever (except as my duties as an employee of the Company may require) any Proprietary information obtained during my employment by the Company, nor display for any purpose whatsoever any drawing, letter, report, or other form of Proprietary information, or any copies or reproduction thereof, belonging to or pertaining to the Company without due written authorization from a responsible officer thereof.

4. I further agree that I will notify the Company in writing before I make any disclosure to the Company, or perform or cause to be performed any work for or on behalf of the Company, which appears to threaten conflict with (a) rights I claim in any invention or idea (i) conceived by me or others prior to my employment or (ii) otherwise outside the scope of this agreement or (b) rights of others arising out of obligations incurred by me (i) prior to this agreement or (ii) otherwise outside the scope of this agreement. In the event of my failure to give notice under the circumstances specified in (a) of the foregoing, the Company may assume that no conflicting invention or idea exists, and I agree that I will make no claim against the Company with respect to the use of any such invention or idea in any work or the product of any work which I perform or cause to be performed for or on behalf of the Company.

This agreement shall be binding upon my heirs, executors, administrators, or other legal representatives or assigns.

I represent that except as stated immediately herebelow I have no agreements with, or obligations to, others in conflict with the foregoing.

In witness whereof I have hereunto set my hand at Corning, New York on this 30 day of August, 19 93.

Witness:

Nancy White

G. J. Smith
Signature in Full